

REMARKS

Entry of the foregoing amendments is respectfully requested.

Summary of Amendments

By the foregoing amendments independent claims 18, 37 and 42 are amended.

Claims 18-43, i.e., all claims of record, remain pending.

Support for the amended claims can be found throughout the present specification (see comments below).

Summary of Office Action

As an initial matter, Applicants note with appreciation that the Examiner has indicated consideration of the Supplemental Information Disclosure Statement filed June 20, 2006 by returning a signed and initialed copy of the Form PTO-1449 submitted therein.

Claims 18-43 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing new matter.

Claims 18-24, 28-31, 34, 36-39, 42 and 43 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Bellon et al., FR 2,789,397 (hereafter "BELLON").

Claims 25-27, 32, 33, 40 and 41 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over BELLON and further in view of Snyder, U.S. Patent No. 4,708,813 (hereafter "SNYDER").

Claim 35 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over

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BELLON in view of Saint-Leger et al., U.S. Patent No. 5,939,077 (hereafter "SAINT-LEGER").

Claims 18-22, 28-33, 35, 42 and 43 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Beutler et al., U.S. Patent No. 4,404,388 (hereafter "BEUTLER").

Claim 42 is rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Penska et al., EP 0 938 890 (hereafter "PENSKA").

Claims 18-41 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 15-34 and 43 of Application No. 10/469,695; claims 16-31, 34, 35, 45, 47 and 48 of Application No. 10/469,696; claims 17-32, 35, 36, 47 and 48 of Application No. 10/469,697; claims 14-29, 32, 33, 42 and 43 of Application No. 10/469,698; and claims 13-28, 31, 32 and 40 of Application No. 10/469,074.

Claim 42 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 15-17 of Application No. 10/760,088.

Response to Office Action

Reconsideration and withdrawal of the rejections of record are respectfully requested in view of the foregoing amendments and the following remarks.

Response to Rejection under 35 U.S.C. § 112, First Paragraph

Claims 18-43 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing new matter. Specifically, the Examiner takes the position that in independent claims 18, 37 and 42 the term “polyethoxylated fatty acids” in connection with emulsifier B should be replaced by the originally disclosed term “polyethoxylated fatty acid esters”.

Upon thorough reconsideration of this matter Applicants respectfully submit that it appears that neither the original term “polyethoxylated fatty acid esters” nor the term “polyethoxylated fatty acids” alone adequately describe all types of emulsifiers B which may be used in the claimed preparation. In this regard, the exemplary emulsifiers B recited in, e.g., present claim 31 may be referred to. For example, “PEG-9 stearate” is not adequately described as “polyethoxylated fatty acid ester” in that it is not an ester of a fatty acid which is polyethoxylated but an ester of a fatty acid (stearic acid) and polyethylene glycol-9. Further, PEG-20 glyceryl stearate, for example, is not a “polyethoxylated fatty acid” but a polyethoxylated ester of a fatty acid (stearic acid) and glycerin.

In view thereof, the present independent claims have been amended to recite both types of emulsifiers B, i.e., the originally disclosed “polyethoxylated fatty acid esters having a chain length of from 10 to 40 carbon atoms and a degree of ethoxylation of from 5 to 100” (such as, e.g., PEG-20 glyceryl stearate) and the esters of fatty acids having a chain length of from 10 to 40 carbon atoms and polyethylene glycol comprising from 5 to 100 ethylene glycol units (such as, e.g., PEG-9 stearate).

Applicants respectfully request that in view of the amended independent claims submitted herewith the rejection of claims 18-43 under 35 U.S.C. § 112, first paragraph be withdrawn.

Response to Rejection of Claims under 35 U.S.C. § 103(a) over BELLON

Claims 18-24, 28-31, 34, 36-39, 42 and 43 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over BELLON for essentially the same reasons that have already been set forth in the previous Office Action. The rejection again relies mainly on Example 1 of BELLON and alleges that this example discloses a facial foam composition which comprises 22 % by weight of PEG-100 stearate glyceryl stearate (allegedly corresponding to emulsifier B according to the present claims), 12 % by weight of stearic acid (corresponding to emulsifier A according to the present claims) and 6 % by weight of octyldodecanol (corresponding to co-emulsifier C according to the present claims) as well as 70 % by volume of nitrogen. The rejection concedes that BELLON does not exemplify a preparation wherein the total amount of emulsifiers A, B and C is from 2 to 20 % by weight of the preparation but essentially alleges that it would have been obvious for one of ordinary skill in the art to provide a corresponding preparation.

Applicants respectfully traverse this rejection. As an initial matter, Applicants point out that it is not even certain that the “PEG-100 stearate glyceryl stearate” used in Example 1 of BELLON falls within the definition of emulsifier B recited in the present independent claims in that it is not clear what exactly the structure of this compound is. Applicants were unable to find literature which indicates the structure of this compound.

Further, even if one were to assume, *arguendo*, that “PEG-100 stearate glyceryl stearate” is within the scope of the definition of emulsifier B as recited in the present claims, the fact remains that the total amount of emulsifiers A to C according to Example 1 of BELLON is 22 % + 12 % + 6 % = 40 %. Even if it is taken into account that the total concentrations indicated in Example 1 of BELLON add up to a little over 120 %, the total

concentration of emulsifiers A to C, normalized to 100 %, would still be about 33 %, i.e., well above the total concentration of 20 % by weight recited in present independent claims 18 and 42, and even further above the total concentration of 15 % by weight recited in, e.g., present independent claim 37.

The Examiner appears to take the position that it would have been obvious to one of ordinary skill in the art to change (reduce) the total amount of emulsifiers A, B and C used in Example 1 thereof to make it fall within the claimed range of from 2 % to 20 % by weight. However, BELLON does not provide any motivation whatsoever to change (optimize) the total amount of emulsifiers A to C in Example 1.

Applicants point out that a particular parameter (here: the total amount of emulsifiers A, B and C) must first be recognized as result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be recognized as routine experimentation. In re Antonie, 559 F.2d 617, 195 USPQ 6 (CCPA 1977).

Applicants further point out that BELLON does not even discuss the compounds which allegedly correspond to the present emulsifiers A, B and C in combination, let alone as an emulsifier system, but mentions them separately and for different purposes, if at all.

Specifically, the stearic acid of Example 1 is discussed as a possible constituent of the lipophilic phase of the composition of BELLON, which composition comprises 5 to 25 % by weight of a lipophilic phase and 65 to 85 % by weight of an aqueous or hydrophilic phase (see, e.g., page 5, third paragraph and page 6, third full paragraph of the English language translation of BELLON (of record)).

The "oxyethylenated (or not) fatty acids" of BELLON which may or may not be

intended to encompass the “PEG-100 stearate glyceryl stearate” of Example 1 are mentioned, among many others, as (optional) traditional cosmetic adjuvants of the composition (see, e.g., page 8, second paragraph of the English language translation of BELLON).

The intended purpose of the third component of interest of Example 1 of BELLON, i.e., octyldodecanol, does not appear to be identified, let alone discussed, in BELLON at all.

In view of the foregoing, Applicants are unable to see why one of ordinary skill in the art would recognize that it might be beneficial to optimize the total amount of the combination of stearic acid, “PEG-100 stearate glyceryl stearate” and octyldodecanol in the composition of Example 1 of BELLON.

In other words, the question is not whether one of ordinary skill in the art could have optimized the total amount of the three components of interest, but for which reason he or she would have done so. The present Office Action does not explain wherefrom a corresponding motivation (and expectation of success) is supposed to come from.

To sum up, one of ordinary skill in the art is not provided with any motivation whatsoever by BELLON to optimize the total amount of the combination of the three compounds which allegedly correspond to the present emulsifiers A to C in Example 1 thereof in any gas-containing cosmetic or dermatological preparation, let alone to reduce the total amount of these three compounds by at least about 13 % (i.e., more than a third) in comparison to that of Example 1 of BELLON.

For at least all of the foregoing reasons, BELLON fails to render obvious the subject matter of any of the claims submitted herewith. Accordingly, withdrawal of the rejection

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under 35 U.S.C. § 103(a) over BELLON is warranted, which action is respectfully requested.

Response to Rejection of Claims under 35 U.S.C. § 103(a) over BELLON in View of SNYDER or SAINT-LEGER

Dependent claims 25-27, 32, 33, 35, 40 and 41 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over BELLON in view of SNYDER or in view of SAINT-LEGER.

These rejections are respectfully traversed as well. Neither SNYDER nor SAINT-LEGER cure any of the deficiencies of BELLON set forth above and for this reason alone, a combination of the teachings of BELLON and SNYDER or SAINT-LEGER fails to render obvious the subject matter of any of the present claims. Under these circumstances it does not appear necessary to comment on the corresponding allegations set forth in the present Office Action. However, Applicants' silence in this regard is by no means to be construed as an admission that any of these allegations are meritorious.

For at least the reasons set forth above, withdrawal of the rejection under 35 U.S.C. § 103(a) over BELLON in view of SNYDER or SAINT-LEGER is warranted and respectfully requested.

Response to Rejection of Claims under 35 U.S.C. § 102(b) over BEUTLER

Claims 18-22, 28-33, 35, 42 and 43 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated BEUTLER. In this regard, the rejection appears to rely on Example 7/2 of BEUTLER.

Applicants respectfully traverse this rejection as well. Specifically, present independent claims 18 and 42 recite the presence of at least one emulsifier B, i.e., of an ester of a fatty acid having a chain length of from 10 to 40 carbon atoms and polyethylene glycol comprising from 5 to 100 ethylene glycol units and/or of a polyethoxylated fatty acid ester having a chain length of from 10 to 40 carbon atoms and a degree of ethoxylation of from 5 to 100. The composition of Example 7/2 of BEUTLER does not contain a corresponding compound and neither does the remaining disclosure of BEUTLER appear to teach a composition which could reasonably be considered to anticipate the subject matter of any of the present claims.

For at least the foregoing reasons, the rejection of claims 18-22, 28-33, 35, 42 and 43 under 35 U.S.C. § 102(b) as over BEUTLER is without merit and should be withdrawn, which action is respectfully requested.

Response to Rejection of Claim 42 under 35 U.S.C. § 102(b) over PENSKA

Claim 42 is rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by PENSKA. In this regard, the rejection appears to rely on Examples 6 and 7 of PENSKA.

Applicants respectfully traverse this rejection. Claim 42 recites a method of preparing a cosmetic or dermatological preparation which comprises a gaseous ingredient, which method comprises rendering the preparation self-foaming and/or foam-like by incorporating therein the emulsifier system according to the present invention.

Applicants are unable to see that the compositions of Examples 6 and 7 of

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PENSKA are indicated to be self-foaming and/or foam-like. For this reason alone, PENSKA does not anticipate the method of present claim 42.

Response to Provisional Rejections of Claims under Doctrine of Obviousness-Type Double Patenting

Claims 18-42 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over several claims of Application Nos. 10/469,695; 10/469,696; 10/469,697; 10/469,698; 10/469,074 and 10/760,088.

Applicants respectfully request that these rejections be held in abeyance until the Examiner has indicated allowable subject matter. Applicants will then decide whether it is necessary to file Terminal Disclaimers in the present application.

CONCLUSION

In view of the foregoing, it is believed that all of the claims in this application are in condition for allowance, which action is respectfully requested. If any issues yet remain which can be resolved by a telephone conference, the Examiner is respectfully invited to contact the undersigned at the telephone number below.

Respectfully submitted,
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